

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Kevin W. Eyres, et al. § Art Unit: 2139
§
Serial No.: 10/642,900 §
§ Examiner: Farid Homayounmehr
Filed: August 18, 2003 §
§
For: Installing Software in a System § Atty. Dkt. No.: 200304043-3
§ (HPC.0068C2US)

Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF PURSUANT TO 37 C.F.R § 41.37

Sir:

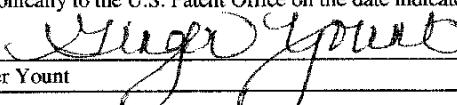
The final rejection of claims 1, 3, 4, 6-9, 12, 15, 16, 18, and 20 is hereby appealed.

I. REAL PARTY IN INTEREST

The real party in interest is the Hewlett-Packard Development Company, LP. The Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

None.

Date of Deposit:	<u>December 1, 2008</u>
I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent Office on the date indicated above.	
 Ginger Yount	

III. STATUS OF THE CLAIMS

Claims 1, 3, 4, 6-9, 12, 15, 16, 18, and 20 have been finally rejected and are the subject of this appeal. Claims 2, 5, 10, 11, 13, 14, 17, and 19 are cancelled.

IV. STATUS OF AMENDMENTS

No Amendment after the Final Rejection of July 10, 2008, was submitted. All amendments have therefore been entered.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R. § 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

Independent claim 1 recites a method of installing software in a system, comprising:

during an installation procedure, providing (Fig. 3A:308) a user prompt to request entry of a key (Spec., p. 8, ¶ [0033], lines 9-11);

determining (Fig. 3A:312) whether an entered key is proper (Spec., ¶ [0033], lines 18-20);

in response to determining that the entered key is proper, installing (Fig. 3B:316) the software in the system and storing (Fig. 3B:322) the entered key (Spec., p. 9, ¶ [0033], lines 30-33);

in response to determining that the entered key is not proper, installing (Fig. 3B:316) the software in the system and enabling activation (Fig. 3B:314) of first code to prompt for entry of the key at a later time (Spec., p. 9, ¶ [0033], lines 28-30);

after enabling activation of the first code, executing (Fig. 4A:404) the first code during a boot procedure of the system (Spec., p. 9, ¶ [0034], lines 3-5); and

during execution of the first code, providing (Fig. 4A:410) another prompt for entry of a second key (Spec., p. 9, ¶ [0034], lines 8-9).

Independent claim 9 recites a system comprising:

a processor (Fig. 1:32); and

a storage (Fig. 1:84) containing installation code for operating software executable by the processor, the installation code when executed ((Spec., p. 8, ¶ [0033], lines 8-9) to cause the processor to:

provide (Fig. 3A:308) a prompt to request entry of a first key (Spec., p. 8, ¶ [0033], lines 9-11);

determine (Fig. 3A:312) whether the first key is proper (Spec., ¶ [0033], lines 18-20);

in response to determining that the first key is proper, install (Fig. 3B:316) the operating software and store (Fig. 3B:322) the first key in the storage (Spec., p. 9, ¶ [0033], lines 30-33);

in response to determining that the first key is not proper, install (Fig. 3B:316) the operating software and enable activation (Fig. 3B:314) of first code to prompt for entry of a key at a later time (Spec., p. 9, ¶ [0033], lines 28-30);

after enabling activation of the first code, execute (Fig. 4A:404) the first code during a boot procedure of the system (Spec., p. 9, ¶ [0034], lines 3-5),

wherein execution of the first code causes the processor to:

provide (Fig. 4A:410) another prompt for entry of a second key (Spec., p. 9, ¶ [0034], lines 8-9); and

determine (Fig. 4A:418) whether the second key is proper (Spec., p. 9, ¶ [0034], lines 14-16)

Independent claim 16 recites an article comprising at least one storage medium containing instructions that when executed cause a system to:

during an installation procedure, provide (Fig. 3A:308) a user prompt to request entry of a key (Spec., p. 8, ¶ [0033], lines 9-11);

determine (Fig. 3A:312) whether an entered key is proper (Spec., ¶ [0033], lines 18-20);

in response to determining that the entered key is proper, install (Fig. 3B:316) the software in the system and store (Fig. 3B:322) the entered key (Spec., p. 9, ¶ [0033], lines 30-33);

in response to determining that the entered key is not proper, install (Fig. 3B:316) the software in the system and enable activation (Fig. 3B:314) of first code to prompt for entry of the key at a later time (Spec., p. 9, ¶ [0033], lines 28-30);

after enabling activation of the first code, execute (Fig. 4A:404) the first code during a boot procedure of the system (Spec., p. 9, ¶ [0034], lines 3-5); and

during execution of the first code, provide (Fig. 4A:410) another prompt for entry of a second key (Spec., p. 9, ¶ [0034], lines 8-9).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. **Whether claims 1, 3, 4, 6-9, 12, 15, 16, 18, and 20 are unpatentable under 35 U.S.C. § 103(a) over Dolphin (U.S. 5,457,746) and further in view of Richman (U.S. 6,003,097).**

VII. ARGUMENT

A. **Whether claims 1, 3, 4, 6-9, 12, 15, 16, 18, and 20 are unpatentable under 35 U.S.C. § 103(a) over Dolphin (U.S. 5,457,746) and further in view of Richman (U.S. 6,003,097).**

1. Claims 1, 3, 4, 6-9, 12, 15, 16, 18, and 20.

It is respectfully submitted that the obviousness rejection of claim 1 over the asserted combination of Dolphin and Richman is erroneous.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as the U.S. Supreme Court held, it is important to

identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

Here, a comparison of the claimed subject matter and the hypothetical combination of Dolphin and Richman will reveal that the claimed subject matter is significantly different from the teachings of Dolphin and Richman.

The Examiner conceded that Dolphin fails to disclose the following elements of claim 1: (1) after enabling activation of the first code, executing the first code during a boot procedure of the system; and (2) during execution of the first code [during the boot procedure of the system], providing another prompt for entry of a second key. 7/10/2008 Office Action at 7. However, the Examiner cited Richman as disclosing the claimed subject matter missing from Dolphin. *Id.*

It is respectfully submitted that Richman provides no teaching of executing the first code [to prompt for entry of the key at a later time] during a boot procedure of the system, and during execution of such first code, providing another prompt for entry of a second key. Richman is related to automatically configuring a network adapter without manual intervention. See Richman, Abstract. As described in Fig. 4A of Richman (also cited by the Examiner), a procedure is depicted for obtaining information from devices of a computer, conducting an inquiry to identify a subset of devices that must be active upon completion of the boot process (step 54 in Fig. 4A) and obtaining a boot-level device driver for each of the devices required to be activated to enable communications between the boot-level devices and the computer of Richman. Richman, 19:53-20:15. The Examiner pointed specifically to step 54 of Richman, which relates to the inquiry to identify the subset of devices that must be active upon completion of a boot process. Identifying devices for completion of a boot process, as taught by Richman, is

completely unrelated to the claimed subject matter, which recites executing first code (to prompt for entry of the key at a later time) during a boot procedure of the system, and during execution of such first code, providing another prompt for entry of a second key.

In response to the arguments presented above, the Examiner argued that Fig. 4A and step 54 of Richman “was cited to show the limitation of executing a code during the boot procedure.” 7/10/2008 Office Action at 2. The apparent implication here is that the remaining teachings of Richman were ignored or otherwise not considered by the Examiner in rendering the obviousness rejection. Not considering the entirety of the teachings of a reference constitutes error. Here, if the teachings of Richman were considered in their proper context, it is clear that Richman provides no teaching or hint of the subject matter in claim 1 that was conceded by the Examiner to be missing from Dolphin.

According to the Examiner, the teachings in column 6, line 58 to column 7, line 28, of Dolphin could be combined with Richman to achieve the claimed features discussed above. 7/10/2008 Office Action at 2. The cited passage of Dolphin refers to a zeroization feature of Dolphin in which a key is “zeroized” or rendered useless after a passage of time or after one or a few reviews of data. The nature of the zeroization feature of Dolphin is that the actual use of the key is monitored, which occurs during normal system operation in which software is executed. What the Examiner is proposing with the modification of Dolphin based on the teachings of Richman is that the zeroization process of Dolphin be performed during a boot procedure, which makes no practical sense. A key for accessing data, as taught by Dolphin, is not used during a boot procedure, but rather, is used during normal system operation. Therefore, the boot process in Richman, which refers to identifying a subset of devices that must be active upon completion

of a boot process, is completely unrelated to the zeroization mechanism of Richman, and also, is also completely unrelated to the claimed invention.

Therefore, the Examiner erred in alleging that Richman discloses claimed subject matter conceded to be missing from Dolphin.

The Examiner also erred when Examiner misapplied Dolphin to the following clause of claim 1: “in response to determining that the entered key is proper, installing the software in the system and storing the entered key.”

In Dolphin, a user wishing to access data on a CD sends a request to a billing/access center to receive a key to access the desired data. Based on the particular data set that the user wishes to access on the CD, the billing/access center downloads the appropriate key to the user where it is then stored on the user’s PCMCIA card or other appropriate hardware. Once stored, the key then can be used to access the desired data on the CD. *See* Dolphin, 6:43-58.

As further taught by Dolphin, a key can be zeroized “after one or only a few reviews of the data or after a short time duration” Dolphin, 7:24-26. When a key is zeroized, further access of data “will require another call to the billing/access center 23.” *Id.*, 8:22-24.

Dolphin does not disclose installing software in the system and storing an entered key **“in response to determining that the entered key is proper,”** as recited in claim 1. In Dolphin, the key is downloaded and stored **“in response to a user request”** for a particular key and then used or entered to access data. As such, an **entered key** is not stored **“in response to determining that the entered key is proper,”** as recited in claim 1. In other words, in Dolphin, a user requests a key from the billing/access center, and the key is downloaded in response to such request. There is no further verification of the key to determine that the key is proper, followed by further storing of the previously entered key in response to such verification.

The Examiner argued that “Dolphin teaches subsequent use of the key after the key is used for the first time,” and that “when the key is verified and determined proper, it will be stored in the user PCMCIA for the subsequent use.” 7/10/2008 Office Action at 3. The Examiner cited specifically to column 6, lines 54-65, of Dolphin to support this argument. Note that the cited passage of Dolphin refers to downloading the key into the user’s PCMCIA card, with the key used to access a data set of a CD-ROM. The cited passage also refers to maintaining and auditing subsequent use of the key by a local user environment after the first use of the key. However, it is noted that once the key has been already downloaded in response to user request for storing in the PCMCIA card, there would be absolutely no reason to store the key again, as apparently argued by the Examiner. The specific clause of claim 1 is that the entered key is stored **in response to determining that the entered key is proper**. On the other hand, in Dolphin, once the key has been stored in the PCMCIA card after the user has made the request to download the key, there would be no need to further store the key in response to determining that the entered key is proper.

The Examiner also referred to the zeroization feature of Dolphin, and argued that “the key must be stored in PCMCIA after it is verified and determined that it is not expired, so that it can be used for subsequent access.” *Id.* at 3. Again, the key has already been stored in the PCMCIA card. Determining whether the key has expired merely refers to auditing usage of the key such that the key can be continued to be used. Therefore, this aspect of Dolphin also does not provide any teaching or hint of storing an entered key in response to determining that the entered key is proper.

In view of the foregoing, it is clear that the hypothetical combination of Dolphin and Richman would not have led to the claimed subject matter.

Moreover, it is respectfully submitted that a person of ordinary skill in the art would not have been prompted to combine the teachings of Dolphin and Richman. As discussed above, Dolphin relates to downloading a key to a PCMCIA card for the purpose of accessing content of a CD. On the other hand, Richman refers to configuring devices during a boot procedure. Such teaching of Richman is completely unrelated to the teachings of Dolphin. The Examiner has failed to provide any explanation of why configuration of devices such as network adapters, as taught by Richman, would have any relevance in the context of Dolphin, which relates to downloading a key from a billing/access center to a PCMCIA card, and using that key to access content of a CD.

Since no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of Dolphin and Richman, the obviousness rejection of claim 1 and its dependent claims is further defective for this additional reason.

Independent claims 9 and 16, and their respective dependent claims, are allowable for similar reasons as claim 1.

In view of the foregoing, reversal of the final rejection and allowance of all pending claims is respectfully requested.

Respectfully submitted,

Date: Dec 1, 2008


Dan C. Hu
Registration No. 40,025
TROP, PRUNER & HU, P.C.
1616 South Voss Road, Suite 750
Houston, TX 77057-2631
Telephone: (713) 468-8880
Facsimile: (713) 468-8883

VIII. APPENDIX OF APPEALED CLAIMS

The claims on appeal are (claims 2, 5, 10, 11, 13, 14, 17, and 19 are cancelled):

- 1 1. A method of installing software in a system, comprising:
 - 2 during an installation procedure, providing a user prompt to request entry of a key;
 - 3 determining whether an entered key is proper;
 - 4 in response to determining that the entered key is proper, installing the software in the system and storing the entered key;
 - 6 in response to determining that the entered key is not proper, installing the software in the system and enabling activation of first code to prompt for entry of the key at a later time;
 - 8 after enabling activation of the first code, executing the first code during a boot procedure of the system; and
 - 10 during execution of the first code, providing another prompt for entry of a second key.
- 1 3. The method of claim 1, further comprising:
 - 2 determining, by the first code, whether the second key is proper; and
 - 3 not executing the installed software in response to the second key not being proper.
- 1 4. The method of claim 3, further comprising storing the second key in a registry in response to the second key being proper.
- 1 6. The method of claim 4, further comprising:
 - 2 during execution of the installed software, providing a prompt for entry of a third key.
- 1 7. The method of claim 6, further comprising:
 - 2 determining whether the third key is proper; and
 - 3 stopping execution of the installed software in response to determining that the third key is not proper.

1 8. The method of claim 1, further comprising:
2 during execution of the installed software, providing a prompt for entry of a third key;
3 determining whether the third key is proper; and
4 stopping execution of the installed software in response to determining that the third key
5 is not proper.

1 9. A system comprising:
2 a processor; and
3 a storage containing installation code for operating software executable by the processor,
4 the installation code when executed to cause the processor to:
5 provide a prompt to request entry of a first key;
6 determine whether the first key is proper;
7 in response to determining that the first key is proper, install the operating
8 software and store the first key in the storage;
9 in response to determining that the first key is not proper, install the operating
10 software and enable activation of first code to prompt for entry of a key at a later time;
11 after enabling activation of the first code, execute the first code during a boot
12 procedure of the system,
13 wherein execution of the first code causes the processor to:
14 provide another prompt for entry of a second key; and
15 determine whether the second key is proper.

1 12. The system of claim 9, wherein execution of the first code causes the processor to further:
2 in response to determining that the second key is proper, enable execution of the
3 operating software and store the second key in the storage; and
4 in response to determining that the second key is not proper, not execute the operating
5 software.

1 15. The system of claim 9, wherein the storage contains a registry to store the first key in
2 response to determining that the first key is proper.

- 1 16. An article comprising at least one storage medium containing instructions that when
2 executed cause a system to:
 - 3 during an installation procedure, provide a user prompt to request entry of a key;
 - 4 determine whether an entered key is proper;
 - 5 in response to determining that the entered key is proper, install the software in the
6 system and store the entered key;
 - 7 in response to determining that the entered key is not proper, install the software in the
8 system and enable activation of first code to prompt for entry of the key at a later time;
 - 9 after enabling activation of the first code, execute the first code during a boot procedure
10 of the system; and
 - 11 during execution of the first code, provide another prompt for entry of a second key.
- 1 18. The article of claim 16, wherein the instructions when executed cause the system to
2 further:
 - 3 determine, by the first code, whether the second key is proper; and
 - 4 not execute the installed software in response to the second key not being proper.
- 1 20. The article of claim 18, wherein the instructions when executed cause the system to
2 further:
 - 3 during execution of the installed software, provide a prompt of another key in response to
4 the entered key and the second key not being proper.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.